

## REMARKS

### I. Introduction

In a nonfinal Office Action dated April 20, 2009, the Examiner rejected claims 37-42 and 48-58 under 35 U.S.C. § 103(a) over a combination of U.S. Publication No. 2001-0029455 ("Chin") and U.S. Publication No. 2002-0188670 ("Stringham"). Applicant herein amends claims 37 and 48 to more clearly identify the subject matter for which applicant seeks protection. Claims 37-42 and 48-58 are pending. For reasons discussed in detail below, applicant respectfully submits that the pending claims are in condition for allowance.

### II. Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 37-42 and 48-58 under 35 U.S.C. § 103(a) over a combination of Chin and Stringham. Applicant respectfully traverses these rejections and submits that the cited references, individually and in combination, fail to disclose or suggest all of the elements recited by the pending claims.

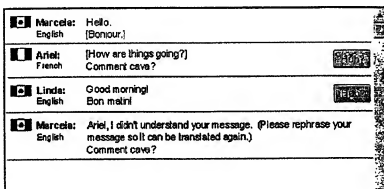
#### A. The cited references fail to disclose or suggest a first device that both sends and receives a translation preference during initiation of an instant messaging session

Claims 37-42 recite "during initiation of [an] instant messaging session between the first device and the second device, sending by the first device to the second device an indication of [a] first translation preference" and "receiving by the first device from the second device an indication of the second translation preference" (emphasis added). It is the Examiner's position that Figure 43 of Chin corresponds to:

[S]ending by the first device to the second device during the established session an indication of the first translation preference" and "receiving by the first device from the second device an indication of the second translation preference (the message sent is displayed in both the source and target languages. Next to the persons name displays their language preference). . .

(Office Action, April 20, 2009, pp. 3-4; emphasis added). First, applicant submits that the Examiner's interpretation of the claims disregards that independent claim 37 recites that the first device both sends and receives a translation preference during initiation of an instant messaging session. Until an instant messaging session is initialized, users cannot exchange messages (see, e.g., U.S. Published Application No. 2003/0125927, ¶ [0025]). Second, Chin does not disclose or suggest *any* device that both sends and receives a translation preference during initiation of an instant messaging session, as recited. Figure 43 of Chin, which is reproduced below for convenience, shows an established chat room.

Figure 43: The Help Button



Even assuming that the languages listed under each users' name corresponds to an indication of a language preference, nowhere does Chin disclose or suggest that the language preference is received by *any* of the users' computers during initiation of the chat room. Indeed, each user's language preference is displayed with the user's message. Nevertheless, to more clearly identify the subject matter for which applicant seeks protection, independent claim 37 has been amended to recite that the first device both sends and receives a translation preference "during initiation of an instant messaging session between the first device and the second device, and prior to any message received from the first user being transmitted to the second device" (emphasis added). Accordingly, applicant respectfully requests that the Examiner reconsider and

withdraw the rejection of claims 37-42 under 35 U.S.C. § 103(a) over the combination of Chin and Stringham.

Independent claim 48 recites “a component of the first device that, during the establishment of the instant messaging session, receives from the second device an indication of the second translation preference...wherein the indication of the second translation preference is received prior to any message received from the first user being transmitted to the second device” (emphasis added). Accordingly, for similar reasons to those discussed above with respect to claim 37, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 48-52 under 35 U.S.C. § 103(a) over the combination of Chin and Stringham.

- B. The cited references fail to disclose or suggest a first device that translates a message from a first translation preference to a second translation preference based on the received indication of the second translation preference

Claims 37-42 recite “based on the received indication of the second translation preference, translating by the first device the received first message from the first translation preference to the second translation preference.” Claims 48-52 recite “a component of the first device . . . that automatically translates the first message from the first translation preference to the second translation preference received during the establishment of the instant messaging session.” Thus, the claims recite that the first device receives a translation preference from the second device and uses that received translation preference to translate messages before sending them to the second device.

Although the Examiner acknowledges that Chin does not disclose that “the translation is done by the first device based on the received indication of the second translation preference” (Office Action, April 20, 2009, p. 4; emphasis added), the Examiner asserts that Stringham cures this deficiency. In particular, the Examiner asserts that:

Stringham discloses a method and system wherein the language translation may be performed using automated language translation software that is incorporated into the program (abstract with paragraph 0016) and on the device where the language used by the associated designated correspondent is retrieved (paragraph 0019), to enable a message translation.

(*id.*; emphasis added). The Examiner's characterization of Stringham does not suggest, or identify where, Stringham discloses that the translation of a message is based on a language preference received from the device of the party (i.e., designated correspondent) to whom the translated message is to be sent, as recited. Moreover, nowhere does Stringham disclose or suggest that the language translation is performed based on such a received language preference. In the relied upon sections, Stringham states that "the e-mail program accesses and searches the first database to find the location where information associated with the designated correspondent is stored and retrieves the name of the language used by the designated correspondent, i.e., the information contained in the seventh data field" (Stringham ¶ [0018]). However, Stringham does not disclose or suggest that the retrieved language used by the designated correspondent is received from the device of the designated correspondent. Indeed, Stringham indicates that such information is provided by the user of the e-mail program (*see, e.g., id.* ¶¶ [0005], [0017]). Thus, applicant respectfully submits that Stringham does not disclose or suggest translating based on such a "received indication of the second translation preference," as recited. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 37-42 and 48-52 under 35 U.S.C. § 103(a) over the combination of Chin and Stringham.

C. There is no reason to combine Chin and Stringham, at least because the combination would change the principle operation of Chin

To establish a *prima facie* case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue" (*KSR Int'l Co.*, 127 S. Ct. at 1740-41). The Examiner's analysis "should be made explicit" (*id.*). That is, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness" (*id. citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

The Examiner asserts that one would be motivated to combine Chin and Stringham "to enable language translation that allows the translation to be done by the device itself" (Office Action, April 20, 2009, p. 5). Applicant disagrees with this assertion and submits that one skilled in the art would not combine Chin and Stringham to enable language translation to be performed by the user's device, as suggested by the Examiner, because the proposed combination would change the principal operation of Chin's chat server. Chin makes clear that "every message that is sent by any one chat client is captured by the chat server, translated, and rebroadcast to every chat client in the chat room" (Chin ¶ [0110]). If Chin were modified to perform translation at each chat client, each chat client would be required to translate each user-entered message from the user's language to all supported languages of the chat room<sup>1</sup> and send a copy of the message in each language to the chat server. As a result, Chin's chat server would receive multiple copies of the same user-entered message and then be required to differentiate between the received messages to correctly rebroadcast the message to every chat client in the chat room. Because the purpose of Chin's chat server is to translate users' messages and rebroadcast those translated messages (*id.* ¶ [0112]), there would be no reason to modify Chin's system to enable language translation to be performed at a user's device. Thus, one skilled in the art would not modify Chin's system to enable language translation to be performed at the user's device, as suggested by the Examiner, because it would change the principal operation of Chin's

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<sup>1</sup> Applicant notes that it would further be necessary for each chat client to be aware of all of the supported languages of the chat room. It appears that a user of Chin's system only becomes aware of another user's language after the user sends a message to the chat room (see, e.g., Chin Figure 43).

chat server. Applicant further submits that one skilled in the art would not seek to combine Chin and Stringham, at least because one skilled in the art would have no reasonable expectation of success. That is, even if it were possible to combine Chin and Stringham without changing the principle operation of Chin, a technique for doing so would entail complexities that would require detailed explanation for one skilled in the art to implement, which is not present in either Chin or Stringham.

Moreover, Chin teaches away from performing translation at each user's device because doing so would require maintaining multiple copies of the translation source code at each user's device (*see, e.g., id.* ¶¶ [0006]-[0007]; "if a source code module uses or produces user-viewable information, then there must be a different copy of the module for each language executable by that software). Specifically, Chin characterizes such systems as "unwieldy, burdensome and costly" (*id.* ¶ [0007]). Thus, one skilled in the art would not modify Chin's system to enable language translation to be performed at the user's device, as suggested by the Examiner, because Chin teaches away from such a modification.

For at least these reasons, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 37-42 and 48-58 under 35 U.S.C. § 103(a) over the combination of Chin and Stringham.

D. The Examiner has failed to establish a prima facie case of obviousness

1. Claims 48-52

The Examiner has failed to make a prima facie case of obviousness with respect to independent claim 48. Claim 48 recites:

48. A computing system of a first device for translating instant messages sent from a first user using the first device to a second user using a second device over a communication network, the first user having a first translation preference and the second user having a second translation preference, comprising:

...

a component of the first device that receives from the second user a second message intended for the first user, the second message composed according to the second translation preference, and that translates the second message from the second translation preference to the first translation preference; and

a component of the first device that provides to the first user the second message translated to the first translation preference.

(emphasis added). The Examiner provides the same rationale for rejecting claims 37 and 48 (Office Action, April 20, 2009, pp. 3-5). However, these claims are directed to different aspects of the invention. Claim 37 is directed to a first device that translates a message to a second translation preference before sending the translated message to a second device that indicated its preference was the second translation preference. As the above-underlined claim language shows, claim 48 recites the additional aspect that a component of a first device receives a message from a second user using a second device and translates the message from the second translation preference of the second user to the first translation preference of the first user. Thus, claims 37 and 48 recite the aspect that a message is translated by a sending device before sending, but claim 48 recites the additional aspect that a message is translated by a receiving device after it is received.

Because the Examiner has not mentioned where Chin and Stringham, individually or in combination, disclose or suggest the above-underlined claim language recited by claim 48, applicant submit that the Examiner has failed to establish a prima facie case of obviousness of claim 48 and each of its dependent claims. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 48-52 under 35 U.S.C. § 103(a) over the combination of Chin and Stringham. However, if the Examiner elects to maintain this rejection, applicant respectfully requests that the Examiner explain where the cited reference disclose each of the components of the first device as recited by claim 48.

## 2. Claims 53-58

The Examiner has failed to make a prima facie case of obviousness with respect to independent claim 53. Claim 53 recites:

53. A method in a computer system for providing real-time communication over a network between first and second users, the method comprising:

receiving first profile information from a first device of the first user, the profile information including first geographic information of the first user;

receiving second profile information from a second device of the second user, the profile information including second geographic information of the second user;

receiving from the first user a first message intended for the second user, translating the first message based on the first geographic information and the second geographic information, and providing the translated first message to the second user; and

receiving from the second user a second message intended for the first user, translating the second message based on the first geographic information and the second geographic information, and providing the translated second message to the first user.

(emphasis added). The Examiner provides the same rationale for rejecting claims 37, 48, and 53 (Office Action, April 20, 2009, p. 6). However, claim 53 is directed to different aspects of the invention. Claim 53 is directed to receiving user profile information that includes geographic information and translating messages exchanged between the users based on their geographic information. Although the Examiner points out that Chin's system includes user profiles that may identify the users' country of origin and location (Chin ¶ [0261]), nowhere does the Examiner assert, nor does Chin disclose or suggest, that Chin's system translates messages based on either the country of origin or location information included in a user's profile. Because the Examiner has not mentioned where Chin and Stringham, individually or in combination, disclose or suggest the elements recited by claim 53, applicant submits that the Examiner has failed to establish a prima facie case of obviousness of claim 53 and each of its dependent claims. Accordingly, applicant respectfully requests that the Examiner



reconsider and withdraw the rejection of claims 53-58 under 35 U.S.C. § 103(a) over the combination of Chin and Stringham. However, if the Examiner elects to maintain this rejection, applicant respectfully requests that the Examiner explain where the cited references disclose each of the elements recited by claim 53.

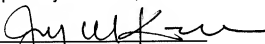
III. Conclusion

In view of the above remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions or believes a telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned directly at (206) 359-6088.

Please charge any deficiencies or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 41826888US from which the undersigned is authorized to draw.

Dated: 8/3/09

Respectfully submitted,

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